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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,349

04/12/2004

Gary D. Rondeau

ASC 301

4733

23581 7590 02/01/2005

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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,349

Applicant(s)

RONDEAU ET AL.

Examiner

Thong Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/27/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings contain four sheets of figures 1-7 were received on 4/12/2004.

These drawings are objected by the Examiner for the following reason(s).

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See present specification in pages 1-2. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: The reference "33" as shown in each of figs. 2-3, and the reference "46" as shown in each of figs. 5-7. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled

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"Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The disclosure is objected to because of the following informalities: The specification is objected to because it does not contain a Summary of the Invention. Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

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REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).

"Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A

"Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Objections

6. Claims 1, 4-5 and 7 are objected to because of the following informalities.

Appropriate correction is required.

a) In claim 1: on line 6, the feature thereof "the XY plate assembly" lacks a proper antecedent basis. Applicant should note that the claim recites an X-axis late and a Y-axis plate (see lines 3-4 of the claim). Should --defined by said X-axis plate and Y-axis plate-- after "the XY plate assembly" to make the feature claimed comply with the requirement of 35 USC 112?

b) In claim 4: on line 1, the feature thereof "the piezoelectric actuators" lacks a proper antecedent basis. Applicant should note that the base claim discloses a piezoelectric actuator mechanism having three spaced-apart portions (see claim 2). Should "actuators" (claim 4, line 1) be changed to --actuator mechanism-- to make the feature claimed comply with the requirement of 35 USC 112?

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c) In claim 5: on line 2, the feature thereof "the three spaced-apart piezoelectric actuators" lacks a proper antecedent basis. Applicant should note that the base claim discloses a piezoelectric actuator mechanism having three spaced-apart portions (see claim 2). Should "actuators" (claim 5, line 2) be changed to --actuator mechanism-- to make the feature claimed comply with the requirement of 35 USC 112?

d) In claim 7: on line 2, the following terms --the steps of-- should be inserted after "comprising".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3, and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sumiya et al (U.S. Patent No. 5,638,206, submitted by applicant).

Sumiya et al discloses an optical apparatus having a microscope for viewing an object. The apparatus as described in columns 7-8 and 14 and shown in fig. 1 comprises a microscope (500), a device for moving a sample from a storage to a stage of the microscope for viewing; and a mechanism for moving the stage supporting a sample in three directions. In particular, the stage moving mechanism comprises a carrier (32Y) movable in a Y-axis direction; a carrier (32X) movable in an X-axis direction, a device (32Z0 disposed between the X-Y

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carrier assembly and the stage carrier (310) for moving the carrier stage in a Z-axis direction. The movement of the carrier stage in the Z-axis direction is for the purpose of bringing the sample to a focus position of the microscope as can be seen in column 14. Regarding to the method as recited in claims 7-10, the steps as recited in the method claimed are readable in the descriptions as provided in column 14 in which Sumiya et al discloses the operations of the X-axis and Y-axis carriers for positioning the sample to the microscope and the operation of the Z-axis device for the purpose of focusing.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo et al (U.S. Patent No. 5,280,677) in view of Sumiya et al (U.S. Patent No. 5,638,206) (both submitted by applicant).

Kubo et al disclose a positioning device for positioning a sample. The positioning device as described in columns 1-2 and shown in figs. 1-2 comprises a XY assembly (9), a movable member (1) supporting a sample and a mechanism comprises three spaced-apart piezoelectric actuators for moving the movable member (1) in a Z-axis direction. The only feature missing from the device provided by Kubo et al is that they do not clearly state that their position device

can be used in a microscope. However, the use of a positioning device having a XY assembly, a member able to move in a Z-axis direction and a mechanism disposed between the XY assembly and the movable member for moving the movable member in a Z-axis direction is known to one skilled in the art as can be seen in the microscope system having a mechanism for moving a stage in three directions provided by Sumiya et al. In particular, Sumiya et al discloses an optical apparatus having a microscope for viewing an object. The apparatus as described in columns 7-8 and 14 and shown in fig. 1 comprises a microscope (500), a device for moving a sample from a storage to a stage of the microscope for viewing; and a mechanism for moving the stage supporting a sample in three directions. In particular, the stage moving mechanism comprises a carrier (32Y) movable in a Y-axis direction; a carrier (32X) movable in an X-axis direction, a device (32Z) disposed between the X-Y carrier assembly and the stage carrier (310) for moving the carrier stage in a Z-axis direction. The movement of the carrier stage in the Z-axis direction is for the purpose of bringing the sample to a focus position of the microscope as can be seen in column 14. It is also noted that the movement of the carriage stage in the Z-axis direction by the piezoelectric actuator is able to make in increments of less than 0.05 micrometer (see column 7, lines 60-66). Regarding to the method as recited in claims 7-10, the steps as recited in the method claimed are readable in the descriptions as provided in column 14 in which Sumiya et al discloses the operations of the X-

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axis and Y-axis carriers for positioning the sample to the microscope and the operation of the Z-axis device for the purpose of focusing.

Thus, it would have been obvious to one skilled in the art to utilize the positioning device as provided by Kubo et al in a microscope system as suggested by Sumiya et al for the purpose of viewing the sample via a microscope.

Conclusion

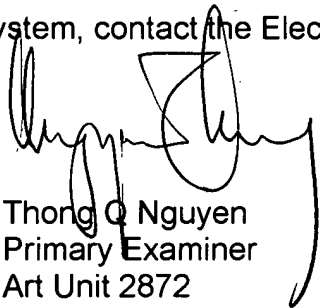
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references are cited as of interest in that each discloses a mechanism for supporting a stage and for moving the stage in three directions.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
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